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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,286	02/19/2004	Timothy W. Perez	8266-1203	4292

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BOSE MCKINNEY & EVANS LLP  
135 N PENNSYLVANIA ST  
SUITE 2700  
INDIANAPOLIS, IN 46204

EXAMINER
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TRETTTEL, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/782,286

Applicant(s)

PEREZ ET AL.

Examiner

Michael Trettel

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 11-14, 16, 21-24, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 5, 7-10, 15, 17-20, 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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15

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102***

Claims 1 to 4, 6, 11 to 14, 16, 21 to 24, 26, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Savage et al (6,401,277). Savage et al shows a siderail extender 30 for use upon one pair of a set of four head and foot end siderails 24, 26 mounted to the supporting frame of an articulated hospital bed. The bed includes a pair of head siderails 24 mounted upon a set of conventional pivot links which allow the siderails to be placed in a raised or lowered position, and a complementary set of foot end siderails 26 mounted in a similar fashion upon pivot links adjacent to the foot section of the bed. As is shown in Figures 9 to 14 the siderails are mounted to the articulated deck of the bed, so as to move with the deck into its various positions. An extender 30 formed by a bridge 32 is pivotally attached to the foot end siderails 26 so as to cover the gap between the head and foot end siderails. The bridge 32 is attached to a coupler 34 that fills a void within the frame of the siderail 26, and pivots around an axis 66 defined by a pivot pin 58. The bridge is formed as an open bottomed U-shaped saddle that includes parallel side walls 60 and a top wall 62 which allows it to sit astride the siderail 26 and slip over the adjacent siderail 24. Note that the orientation of the bridge 32 can be reversed upon the siderails (column 3, lines 42 to 48). As the siderails move relative to one another the bridge pivots upon axis 66 and slides relative to the siderails so as to continuously cover the gap between the siderails. A

Art Unit: 3673

secondary embodiment is shown in Figures 27 to 30 which uses a sliding pivot defined by a slot 564 formed in the bridge that engages the pivot pin, this allows the bridge to translate by sliding and pivoting during movement. The bridge 32 is biased into a downward position by the force of gravity.

#### ***Allowable Subject Matter***

Claims 5, 7 to 10, 15, 17 to 20, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response To Arguments***

Applicant's arguments filed on April 22, 2005 have been fully considered but they are not persuasive.

With regards to the arguments made with respect to claim 1, the applicant has not considered the fact that the extender 30 in Savage moves when it comes into contact with the head siderails 24. This is best shown in Figures 9 to 14 of Savage, where it is shown that the extender pivots upwardly in response to relative movement between the foot and head siderails. Claim 1 does not preclude the object being another siderail, nor does it preclude the possibility of already being in contact with another object when the movement occurs. This is because the limitation drawn to this feature is completely functional in nature (i.e., "wherein the compliant member moves relative"), and as such does not state what the invention is but instead states what the invention is meant to do. In other words, the extender 30 shown in Savage is inherently

Art Unit: 3673

capable of moving in the fashion claimed, even if this fashion is not shown or expressly disclosed by Savage. It is not necessary for the extender 30 of the Savage reference to have to move into contact with a secondary object during movement, nor does it matter that it is resting in place upon a second siderail while it is in use. This is because the extender would move if it came into contact with a secondary object during movement, such as a patient's limb that was placed between the paired siderails. In addition, the examiner submits that when the extender is placed in the storage positions as shown in Figure 26, the extender would move via pivoting if the extender came into contact upon an object placed upon the floor. This would happen if, say, the bed was lowered into a floor adjacent position. A rejection based upon inherency does not need to show all of the limitations of intended use present in the claims, since it is presumed that the reference can perform the functions set forth in the claims. Any recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The argument regarding claim 1 is unpersuasive as a result.

A similar argument has been presented with regards to claims 11 and 21. Claims 11 and 21 both use a series of functional limitations when defining the relationship between the first and second rail members and how they move in relation to an unclaimed object that is inferentially referred to. While such a series of limitations is proper and is considered to be definite under 35 USC 112, they are considerably broader in scope than limitations that define the invention in

Art Unit: 3673

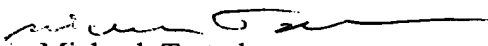
structural terms. The siderail 26 and extender 30 shown in the Savage patent is inherently capable of such movement if it was used in the fashion claimed, this is all that is necessary to support a 102 rejection based upon inherency. Merely changing the terms of the claims slightly while still attempting to define novelty purely within use type limitations does not overcome a §102(e) rejection based upon inherency.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Trettel whose telephone number is (571) 272-7052. The examiner can normally be reached on Monday, Tuesday, Thursday, or Friday from 7.30 am to 5.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford, can be reached on (571) 272-7052. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
Michael Trettel  
Primary Examiner  
Art Unit 3673